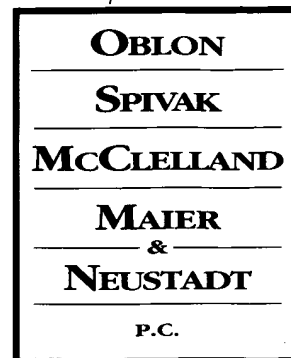




Docket No.: 215106US3

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313



RE: Application Serial No.: 09/977,426  
Applicants: Katsuhiko SAITO, et al.  
2<sup>nd</sup> RCE Filed: April 4, 2005  
For: HEAT EXCHANGER  
Group Art Unit: 3753  
Examiner: LEO, L.

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SIR:

Attached hereto for filing are the following papers:

**PROVISIONAL ELECTION OF SPECIES**

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Gregory J. Maier

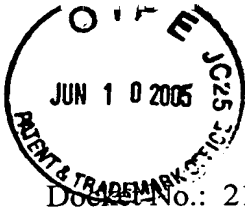
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Doc. No.: 215106US3

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :  
Katsuhiro SAITO, et al. : EXAMINER: LEO, L.  
SERIAL NO.: 09/977,426 :  
2<sup>nd</sup> RCE FILED: April 4, 2005 : GROUP ART UNIT: 3753  
FOR: HEAT EXCHANGER :

PROVISIONAL ELECTION OF SPECIES

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VA 22313-1450

SIR:

In response to the Election of Species requirement dated May 13, 2005, the Applicants provisionally elect with traverse the species of Group I corresponding to Figure 2 and identifies Claims 15-19 as readable on the provisionally elected species and Claims 10-14 as being generic to the two species.

The Applicants respectfully traverse the election requirement for several reasons.

First, the outstanding Official Action merely includes the conclusory statement that "[t]his application contains claims directed to ... patentably distinct species ..." without stating any basis whatsoever in support of such a finding. This is in violation of MPEP § 816, which states:

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. ...

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Response to Election of Species Requirement dated 5/13/05

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness.

Secondly, MPEP § 806.04(f) requires:

Claims to be restricted to different species must be mutually exclusive. ..

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics and this failure provides a further basis for traversing the election requirement.

Finally, MPEP § 803 states:

... If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

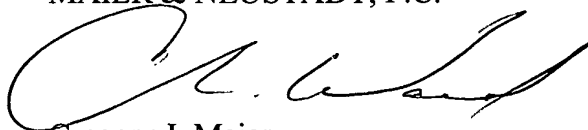
The claims of the present invention would appear to be part of an overlapping search area. Accordingly, the Applicants also respectfully traverse the outstanding Election requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

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Response to Election of Species Requirement dated 5/13/05

Therefore, it is respectfully requested that the requirement to elect a single species be withdrawn, and that a full examination on the merits of Claims 10-24 be conducted.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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